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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,224	06/25/2003	Thomas S. Murphy	3317.126 US1	4383

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EXAMINER

DESAI, ANISH P

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/603,224	Applicant(s) MURPHY ET AL.	
	Examiner Anish Desai	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/25/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 18-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/25/04, 03/17/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to an article, classified in class 428, subclass 304.4
- II. Claims 18-27, drawn to a method of making a pressure sensitive adhesive article, classified in class 156, subclass various.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product (i.e. an article) can be made by another and materially different process. Instead of applying the adhesive to the fabric, coat the backing substrate with the adhesive and then apply the fabric.
2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Ms. Mary Rose Scozzafava on July 11, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-17 drawn to an article. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

5. The disclosure is objected to because of the following informalities: Page 10, line 18-20 of specification states "The fabric can be up to about 95% open, i.e., 5% of surface area of the article is porous fabric, and is typically at least about 50% open." It should be "The fabric can be up to about 95% open, i.e., 5% of surface area of the article is porous fabric, and is typically at least about 90% open."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites "...wherein said second surface covers no more than 50% of the article surface area.". It is unclear as to what the applicant means by "said second surface covers no more than 50% of the article surface area". It seems that the second surface is a part of the claimed article, therefore it is not clear

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whether what it means by "said second surface covers no more than 50% of the article surface area".

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Schneler et al. (US Patent 2,740,403).

8. Schneler et al. teach adhesive bandages for medical and surgical purpose (Column 1, line15-16). The adhesive bandage is a two-ply bandage containing a backing, which is made from a porous fabric and another thickness (known as carrier) made of an open mesh fabric that is impregnated or coated with an adhesive in such manner that the fabric remains substantially porous (Column 1, lines 22-33). The carrier is adhered to one surface of the backing to form two-ply bandage (Column 1, line 33-34). The examiner is equating the carrier of Schneler et al. as claimed adhesive-carrying fabric.

9. Although, Schneler et al. do not explicitly teach that the fabric having porosity greater than that of the backing as claimed, Figure 2 of Schneler et al. shows the upper ply or backing 6 which is a closely woven fabric with openings 7 with the size of each opening being 0.005 in and as shown in the Figure 3, the lower ply or the carrier 8 with the size of each opening being 0.01 in. The lower ply is impregnated or coated with an adhesive (Column 2, lines 42-51). Thus, the backing of Schneler et al. has a lower

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porosity than the carrier because the openings of the backing are smaller in size than the openings of the carrier (i.e. lower ply).

10. Regarding the claimed limitation of adhesive penetration into a portion of a thickness of the porous backing, it is reasonable to presume that the adhesive of Schneler et al. penetrates into the backing, because the backing of Schneler et al. is porous which will allow penetration of the adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneler et al. (US Patent 2,740,403) in view of Murphy et al. (US Patent 5,762,623).

12. The invention of Schneler et al. is previously disclosed. Schneler et al. are silent with respect to teaching the claimed property of the tensile strength as claimed in the claim 1. Thus a skilled artisan in possession of the invention of Schneler et al. would have to look elsewhere to find appropriate fabric with the claimed property (i.e. tensile strength).

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13. Murphy et al. teach a laminated tape/bandage comprising a layer of transversely-spaced, longitudinally-extending elastic strands between a pair of outer layers, at least one of which is a warp-knitted (weft insertion) fabric oriented with knit yarns extending longitudinally and generally parallel to the orientation of the elastic strands (see Abstract). A binder 18 is used to laminate all three layers (Column 3, lines 6-7). The objective of the invention of Murphy et al. is to provide an inexpensive, elastic, hand tear tap, or bandage that can be made either cohesive or adhesive (Column 1, lines 56-60).

14. The warp-knitted fabric layer is shown in Figure 3 of Murphy et al. As shown in Figure 3, the fabric is oriented so that knitted warp yarns 50, extend generally from the left to right, and the loose of non-twisted weft yarns 60 extend vertically (Column 3, lines 41-44). The knitted warp yarns are 45 denier and weft yarns are 150 denier (Column 2, lines 47-49). The examiner is equating the direction of warp yarns to be in the machine direction and the direction of fill or weft yarns to be in the cross direction. Although, Murphy et al. do not explicitly teach that the warp yarns of 45 denier have lower tensile strength than the weft yarns of 150 denier, it is obvious that the warp yarns have lower tensile strength because of the warp yarns of 45 denier are thinner than the weft yarns of 150 denier.

15. Regarding claim 1, a skilled artisan would have found it obvious to use the warp-knitted (weft insertion) fabric layer of Murphy et al. and used it in the invention of Schneler et al. as a carrier. One would be motivated to do this, in order to provide an adhesive bandage that is relatively easy to tear by hand.

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16. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneler et al. (US Patent 2,740,403).

17. The invention of Schneler et al. is previously disclosed. In addition to previously disclosed matters of Schneler et al., Schneler et al. teach that once the backing is united with the carrier, the outer surface of the carrier may have an additional adhesive in dilute form applied such that the outer surface is definitely adhesive (Column 1, lines 71-72, Column 2, lines 1-2). The examiner is equating the outer surface of Schneler et al. as the claimed second surface. Although, Schneler et al. do not explicitly teach the first surface and the second surface of fabric as claimed, it is obvious that the carrier of Schneler et al. has first and second surface (i.e. two surfaces).

18. Claims 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneler et al. (US Patent 2,740,403) in view of Murphy et al. (US Patent 5,762,623).

19. Regarding claims 4 and 5, in addition to previously disclosed matters of Schneler et al., the backing can be a woven material (Column 1, line 26) and carrier can be formed from woven and knitted materials (Column 1, lines 57-58). Although, Schneler et al. do not explicitly teach non-woven and knitted as a backing as claimed in the claim 4 and non-woven as an adhesive carrying fabric as claimed in the claim 5, it is well known in the art that the porous sheet materials are used in tapes in medical field and are generally porous sheets selected from non-woven, woven, or knitted materials (See US Patent 5,914,282, Column 1, lines 18-20).

20. Regarding claims 6 and 7, Schneler et al. are silent with respect to teaching warp knit fabric as claimed in the claim 6 and weft insert yarn as claimed in the claim 7.

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Recall that Murphy et al. disclose a laminated tap/bandage where one of the layers is made from warp-knitted (weft insertion) fabric (see Abstract). The objective of the invention is to provide a tape that can tear easily by hand, inexpensive, and is soft and comfortable to wear (Column 1, lines 57-60).

21. Regarding claims 6 and 7, a skilled artisan would have found it obvious to use warp-knitted (weft insertion) fabric of Murphy et al. and used it as a carrier layer in the invention of Schneler et al. One would be motivated to do this, in order to provide a adhesive bandage that is easy to tear by hand, inexpensive, soft, and comfortable to wear.

22. Regarding claim 8, in addition to previously disclosed matters of Schneler et al., the backing and carrier of the two-ply bandage of Schneler are elastic and extensible in one or both directions (Column 1, lines 40-42, Column 3, lines 3-6).

23. Regarding claims 9-12, Schneler et al. in view of Murphy et al. discloses the claimed invention except for that the adhesive carrying fabric comprises more than 80% open area prior to application of the adhesive as claimed in claim 9, % open area of the adhesive carrying fabric is reduced by no more than 10% upon the application of the adhesive as claimed in the claim 10, backing substrate comprising greater than about 25% open area as claimed in the claim 11, and backing substrate comprising greater than about 50% open area a claimed in the claim 12. It should be noted that the openness of a fabric or % open area is considered as a result effective variable. For example, by having higher percent of open area in the fabric causes the fabric to breath easily, which allows fabric to be more permeable to air.

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24. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have, the adhesive carrying fabric comprising more than 80% open area prior to application of the adhesive as claimed in claim 9, % open area of the adhesive carrying fabric is reduced by no more than 10% upon the application of the adhesive as claimed in the claim 10, backing substrate comprising greater than about 25% open area as claimed in the claim 11, and backing substrate comprising greater than about 50% open area claimed in the claim 12, since it has been held that the discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

25. Regarding claim 13, the inventions of Schneler et al. and Murphy et al. are previously disclosed. Although, Schneler et al. do not explicitly teach that the adhesive penetrates into the one surface of the backing substrate, note that the backing of Schneler et al. is porous, therefore, the adhesive of Schneler et al. will obviously penetrate into the backing.

26. Regarding, claim 14, Schneler et al. in view of Murphy et al. discloses the claimed invention except for that adhesive penetrates into about 25% to 75% of the thickness of the backing substrate. Note that the level of penetration of adhesive into the backing is considered as a result effective variable. For example, higher the amount of adhesive penetration in the backing, stronger the strength of the bond between the fabric and the backing. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the adhesive to penetrate into about 25% to 75% of the thickness of the backing substrate, since it has been held that

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discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

27. Regarding claim 15, Schneler et al. are silent with respect to teaching adhesive with sufficient cohesive strength as claimed. The invention of Murphy et al. is previously disclosed. In addition to previously disclosed matters of Murphy et al., the binder of Murphy et al. that is used in laminating the three layers together to form the finished products can be made cohesive (i.e. will stick only to itself) or adhesive (Column 3, lines 6-10). Note that the examiner is equating the binder of Murphy et al. as an adhesive.

28. Thus a skilled artisan would have found it obvious to use the binder of Murphy et al. with the cohesive property in the invention of Schneler et al. One would be motivated to do this, in order to effectively bond the carrier and backing layers of Schneler et al.

29. Regarding claim 16, the inventions of Schneler et al. and Murphy et al. are previously disclosed. Although, Schneler et al. in view of Murphy et al. do not explicitly teach the claimed property (i.e. an article that tears uniformly), it is reasonable to presume that that said property is present in the product of Schneler et al. in view of Murphy et al. Support for said presumption is found in the use of the like materials. For example, Schneler et al. disclose a porous backing and adhesive impregnated or coated carrier that is made of a fabric. Murphy et al. disclose laminated tape/bandage that is easy to tear by hand. Thus, the presently claimed property is necessarily present in the product of Schneler et al. in view of Murphy et al. The burden is upon the applicant to prove otherwise.

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30. Regarding claim 17, Schneler et al. are silent with respect to teaching elastic yarns.

31. The invention of Murphy et al. is previously disclosed. Recall that, Murphy et al. teach an inexpensive, elastic tape or bandage that can be tear easily by hand. The tape/bandage of Murphy et al. contains a middle layer of longitudinally extending elastic strands (Column 2, lines 33-38). Murphy et al. teach that the compared to prior art laminated products, the appearance, tear characteristics, and longitudinal strength of the tape/bandage of their invention are superior.

32. Thus, a skilled artisan would have found it obvious to use the elastic strands of Murphy et al. in the adhesive bandage of Schneler et al. motivated by the desire to provide an inexpensive elastic bandage that is easy to stretch.

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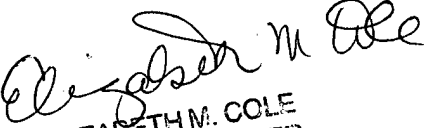
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

apd


ELIZABETH M. COLE
PRIMARY EXAMINER